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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,318	06/19/2000	Frank Venegas JR.	IDS-10505/14	4057
25006	7590	01/27/2006	EXAMINER	
GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C			YIP, WINNIE S	
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3636

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,318

Applicant(s)

VENEGAS, FRANK

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Part II DETAILED ACTION

This office action is in response to applicant's amendment filed on November 14, 2005.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

1. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 14, the phrase "rubber-like" renders the claim indefinite because the claim includes elements not actually disclosed such as a foam piece or a rubber spring, thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).

Further, claim 14 recites the limitation "the resilient portion" which is insufficient antecedent basis for this limitation in the claim. Notice, the "resilient portion" only previously defined in claim 13 but not claim 8. Therefore, claim 14 has been treated on the merits as dependent to claim 13 instead of claim 8. Appropriate correction is required.

Double Patenting

2. Claims 8-10 and 13-14 stand provisionally rejected under the judicially created doctrine of double patenting over claims 7-10, 11 and 22 of copending Application No. 10/827,975. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a cover comprising/consisting an elongated, generally cylindrical plastic sleeve having consistent wall, a hemispherical shaped upper end and an open lower end, and a resilient portion near the lower end in arrangement as claimed.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

3. Claims 8-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Finger et al. (US Patent No.3,319,328).

Finger et al. shows and discloses a cover (see Figs. 6 and 13) for covering a post (31 or 25), the cover consisting of an elongated, generally cylindrical plastic sleeve (34) having an open lower end and a closed, substantially hemispherical shaped upper end (33) to accommodate the configuration of the post, the sleeve (34) having a consistent wall thickness including the closed upper end, the sleeve (34) having an interior diameter such as about 5" (see col. 3, line 47) to cover the post having a diameter of 4 to 9 inches (see col. 5, line 20), therefore, the cover of Finger et al. is considered to have a interior diameter of sleeve being in a range of 3 to 8 inches as claimed, the sleeve is made of plastic such as polyethylene (See col. 5, line 11) and has an

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additive being added to the plastic sleeve by coating or spaying to resist ultraviolet deterioration (see col. 5, lines 15-17).

Claim Rejections - 35 USC § 103

4. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kervin (US Patent No.2,450,345).

Kervin shows and discloses a cover for covering a post (52), the cover consisting of an elongated, uniform and smooth cylindrical plastic sleeve (15) having an open lower end terminating in a non-flared circular edge, and a closed substantially hemispherical shaped upper end (16), the sleeve (15) having an interior diameter and a consistent wall thickness including the closed upper end, and an resilient portion (18) attached near the open lower end for resisting the movement of the cover from the post. Although Kervin does not specifically define the interior diameter, it would have been obvious to one ordinary skill in the art at the time the invention was made to vary the dimensions of the interior diameter of the sleeve of the cover of Kervin as claimed because to do so would merely involve a matter of obvious design choice for the purpose of providing a cover to accommodate various different dimensional posts to be covered since the applicant has not disclosed that the specific diameter of interior of a cover solves any stated problem or is for any particular purpose and it appears that the claimed invention would perform equally well with the sleeve being formed with a preselected diameter in the range of 3 to 8 inches as claimed to achieve the desirable result of covering variety of different dimensioned posts. And, a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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5. Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty (US Patent No. 4,516,756) in view of Arth, Jr. '883.

Beatty shows and discloses a cover for covering a post (12 or 20), the cover consisting of an elongated, uniform and smooth cylindrical plastic sleeve (10 or 18) having an open lower end terminating in a non-flared circular edge, and a closed upper end with variety of shapes, the sleeve (18) having an interior diameter and a consistent wall thickness including the closed upper end. Beatty further teaches the plastic sleeve being made of molded plastic having a durable coloring pigment throughout for providing a cover having color without coating or painting. Although Beatty does not specifically define the sleeve of the cover having the upper end specifically having a hemispherical shape and the interior diameter in a specific range of 3 to 8 inches as claimed, Beatty discloses the sleeve of the cover (10 or 18) may having variety dimensions and shapes for a pleasing appearance. Arth, Jr. teaches a cover for covering a post, comprising an elongated sleeve having a closed and hemispherical shaped upper end for providing a resilient and deformable and cushionable protection and desirable appearance. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the cover of Beatty having the closed upper end of the sleeve specifically formed with a hemispherical shaped end as taught by Arth, Jr. and to vary the dimensions of the interior diameter of the sleeve of the cover of Beatty as claimed because to do so would merely involve a matter of obvious design choice for the purpose of providing a cover to accommodate various dimensional posts to be covered since the applicant has not disclosed that the specific shape of the closed upper end and the specific diameter of interior of a cover solve any stated problem or is for any particular purpose and it appears that the claimed invention would perform equally

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well with the upper end of the sleeve being formed with a hemispherical shape and an interior diameter having a preselected dimension in the range of 3 to 8 inches as claimed to achieve the desirable result of covering variety of different dimensioned posts. And, a change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kervin '345 or Beatty '756 as applied to claim 8 above, and further in view of Arth, Jr. (US patent No. 5,299,883).

Kervin or Beatty teach all structural limitations as claimed as explained and applied above rejections except that Kervin or Beatty does not specifically define what specific type of plastic material that the cover is made. Arth, Jr. teaches a cover comprising an elongated sleeve being made of plastic such as polyethylene (see col. 3, line 29). It would have been obvious to one skilled in the art at the time the invention was made to modify the cover of Kervin or Beatty being made of polymeric plastic such as polyethylene or polycarbonate as taught by Arth, Jr. for forming a cover having advantage of the polymeric plastic's desirable properties such as having sufficient impact strength characterizes, corrosion and wear properties such as thermal expansion, moisture absorption and resistance to chemical attack to allow it being used outdoor. All of the foregoing is within the skills, competence and knowledge of the person with ordinary skills in the covering art.

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7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kervin '345 or Beatty '756 in view of Arth, Jr. '883 as applied to claim 8 above, and further in view of Finger et al. '328.

Kervin or Beatty modified by Arth, Jr. teach all structural limitations as claimed as explained and applied above rejections except that Kervin or Beatty or Arth, Jr. does not specifically define what specific type of plastic material including an additive to resist ultraviolet deterioration. Finger et al. teach a cover for a covering a post comprising an elongated sleeve 27 being made of plastic such as polyethylene and including an additive with a ozone resistant material for protection against ultra violet deterioration (see col. 5, lines 15-17). It would have been obvious to one skilled in the art at the time the invention was made to modify the cover of Kervin for Beatty combined with Arth, Jr. being made of rigid plastic having an additive to resist the ultraviolet deterioration.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kervin '345 or Beatty '756 as applied to claim 8 above, and further in view of Arth, Jr. '883.

Kervin or Beatty teach all structural limitations as claimed as explained and applied above rejections except that Kervin or Beatty does not define the sleeve further including an attached resilient portion which being a rubber ring-like insert near to the open lower end for retaining the sleeve over the post as claimed. Arth, Jr. teach a cover having an elongated sleeve (18) for releasably secured to a post, and a flexible resilient locking strap (12) being disposed on the post near a lower end of the cover for retaining movement of the cover. It would have been obvious to one skilled in the art at the time the invention was made to modify

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the cover of Kervin or Beatty having a flexible resilient strap disposed on the post to define a rubber insert as taught by Arth, Jr. for providing the cover having resilient portion for resisting movement of the cover from the post.

Response to Argument

9. Applicant's arguments filed November 14, 2005 have been fully considered but they are not deemed to be persuasive.

In response to applicant's argument that the flexible resilient strap 12 of Arth, Jr.'s device is not attached to the post, this is not consist to the body of the claimed invention. Notice claim 13 only defines "an attached resilient portion" which is not necessary to be attached to the cover. According to the specification, the resilient portion (40) is attached to or the rubber ring (41) is inserted into the post and positioned near to the open lower end of the cover when the over is placed over the post. No support is define the resilient portion is attached to the lower end of the cover. Therefore, applicant's argument is not persuasive.

In response to applicant's argument that there is no suggestion to combine the references Beatty in view of Arth, Jr., the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). we agree that Beatty does not show the covers and post having a top end with a hemispherical shape, otherwise the rejection will be under 35 USC 102 status. Applicant's argument that Beatty does not disclosed a wooden post would need to be rounded

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off to have the cover including a hemispherical upper end is not persuasive because applicant only claims a cover but not with the post. In fact, Beatty does not limit the device only for covering a post having a point end or flat end as shown. Beatty discloses the cover having variety shaped upper ends for accommodate the shape of variety different shaped posts. In this case, both references to Beatty, and Arth, Jr. teach an assembly comprising a cover receiving a wooden post as claimed except that the top end of the cover. As applicant described in the specification, the cover may be formed with alternative embodiment with the top end can be formed in variety of shapes as shown in Figs. 6-9, 10A and 10B, Beatty discloses an assembly comprising a sleeve and a stanchion having top ends being accommodated with each other with various alternative shapes. Although Beatty does not show the various shapes including a hemispherical shape, Arth, Jr. is used as a teaching reference to teach the cover would have been modified with other shaped top end such as a hemispherical top as claimed. Since applicant has not disclosed that a cover having an closed top end being formed with a hemispherical shaped dome top end provides an advantage, is used for a particular purpose, or solves a stated problem, one of ordinary skill in the art, would have expected applicant's invention to perform equally well with the either an enclosed flatten top end of Beatty or hemispherical shaped dome top as taught by Arth, Jr. as an obvious matter of design choice to accommodate the shape of the stanchion to be used for protecting a penetration of the stanchion through the sleeve and having desirable aesthetic appearance.

Therefore, the rejection still granted.

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ACTION IS FINAL

10. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P. ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. ' 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. ' 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip
Primary Examiner
Art Unit 3636

wsy
January 19, 2006